

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:) Confirmation No.: 2970
Shunpei YAMAZAKI) Group Art Unit: 2822
Serial No. 10/045,902) Examiner: Roy Karl Potter
Filed: January 16, 2002)
For: SEMICONDUCTOR HAVING LOW)
CONCENTRATION OF)
PHOSPHOROUS)

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. §§ 41.41(a)(1) and 41.43(b), Appellants submit this *Reply Brief* in response to the *Examiner's Answer* mailed September 11, 2009.

The *Examiner's Answer* continues to assert that "[t]he alleged errors recited in the oath/declaration do not recite an error in the specification, drawings or claims which cause the original patent to be defective" (page 3) and that "[t]hese are not errors which can be properly corrected by a reissue application" (page 4). The Applicant respectfully disagrees and traverses the assertions in the *Examiner's Answer*. The reissue statute, i.e. 35 U.S.C. § 251, titled "Reissue of Defective Patents," is not limited to just "an error in the specification, drawings or claims." Rather, § 251 sets forth the following: "Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new

and amended application, for the unexpired part of the term of the original patent” (emphasis added). The Appellant specifically described the errors that form the basis for the reissue declaration, for example, at pages 23-34 of the *Appeal Brief*, and these errors include the “reason of the patentee claiming more or less than he had a right to claim in the patent.”

The *Examiner’s Answer* asserts that “[t]he question for Appeal is whether a reissue application is the proper method for correcting an error resulting from a non considered Petition to Withdraw a Terminal Disclaimer” (page 4). However, this statement mischaracterizes the present issues before the Board in that it first implies that there may be some other method for correcting the errors at issue in the present application and then oversimplifies the present errors as “an error resulting from a non considered Petition.” As noted in detail throughout the *Appeal Brief*, there are numerous errors at issue in the present reissue including but not limited to the “error of the Examiner/USPTO in failing to consider and act upon the *Petition to Withdraw* filed 21 months prior to issuance of the subject ‘991 patent” (page 2 of 3, *Reissue Application Declaration by the Inventor*). That is, the Examiner’s statement does not acknowledge the Patent Office’s role in creating the present error or the Applicant’s attempt to bring the *Petition* to the Office’s attention during prosecution when the Applicant stated that “filed herewith is a Petition to Withdraw ... in view of the claim amendments effected since the obviousness-type double patenting rejection was first applied” (*Amendment* filed April 9, 1999). Rather, the Appellants submit that the question for Appeal is whether a reissue application is the proper method for correcting an error by the Patent Office in failing to consider and act on a *Petition to Withdraw a Terminal Disclaimer*, and errors by the Applicant in failing to ensure proper disposition of the *Petition* during prosecution, failing to withdraw the application before or after payment of the issue fee, and failing to defer issuance until the *Petition* was considered. The Appellants believe that each of these errors was made without any deceptive intention and resulted in a patent that is deemed wholly or partly inoperative or invalid, by reason of the patentee claiming less than he had a right to claim in the patent. As such, the errors in question fall squarely within § 251.

The *Examiner's Answer* continues to assert that the holding in *Durckheimer* is somehow contrary to granting of relief in the present application. However, the *Examiner's Answer* appears to ignore the clear holding in *Durckheimer* and the Appellant's discussion of the same as set forth at pages 15-17 of the *Appeal Brief*. Specifically, the *Examiner's Answer* continues to imply that the facts of the present application differ from the "unique set of facts and circumstances" (page 5, citing page 21 of *Durckheimer*). However, in *Durckheimer*, the claims which were subject to a terminal disclaimer were canceled rendering the terminal disclaimer moot. Similarly, in the present application, the claims of the '235 application were substantively amended on August 14, 1997, November 14, 1997, May 11, 1998, and November 4, 1998, thereby rendering the *Terminal Disclaimer* unnecessary and inappropriate. As in *Durckheimer*, the *Terminal Disclaimer* was proper at the time it was filed, and the *Terminal Disclaimer* later became unnecessary because of amendments to the claims. Due to the above-referenced amendments, the claims which were secured by the *Terminal Disclaimer* were no longer pending in the case, and none of the claims of the issued patent would have been subject to an obviousness-type double patenting rejection. Like *Durckheimer*, the *Terminal Disclaimer* in the present application does not secure claims that were issued in the '991 patent. Therefore, the amendments obviated the purpose for which the terminal disclaimer had been originally filed. Therefore, the Applicant's request to withdraw the *Terminal Disclaimer* should be granted, and the aforementioned errors should be corrected by the present reissue application.

Furthermore, the facts of the present case are even more favorable than in *Durckheimer* because the Applicant, 21 months before issuance, filed a subsequent *Petition to Withdraw* and brought such *Petition* to the attention of the Examiner in a subsequent *Amendment*. Also in *Durckheimer*, the Applicants successfully withdrew a terminal disclaimer even after issuance of the patent and even though no attempt was made to request such withdrawal prior to issuance.

The *Examiner's Answer* continues to argue that "reissue ... is not available to correct all errors" and that "public policy does not favor the restoration to the patent owner of something that has been freely dedicated to the public" (page 5; emphasis added). However, the *Examiner's Answer* appears to ignore the Appellant's arguments set forth at pages 14 and 21-22 of the *Appeal Brief*. For example, MPEP § 1490.VII.B states, in part, the following: "As a general principle, public policy does not favor the restoration to the patent owner of something that has been freely dedicated to the public, particularly where the public interest is not protected in some manner - e.g., intervening rights in the case of a reissue patent. See, e.g., Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U.S. 477, 24 USPQ 308 (1935)." There are several important distinctions between MPEP § 1490.VII.B, the facts in Altoona, and the present application. The "disclaimer" in Altoona was not a *Terminal Disclaimer* and the respondent in Altoona did not file such disclaimer before issuance of a patent. Rather, in Altoona, a disclaimer was "filed by respondent shortly before trial ... to add the flywheel device ..." (U.S. 477 at 480). Second, in the present application, the Applicant never freely dedicated to the public the terminal portion of the term of the '991 patent. The record clearly shows that the Applicant, during prosecution and 21 months prior to issuance, sought to withdraw the *Terminal Disclaimer* and never intended to freely dedicate to the public the terminal portion of the '991 patent.

Therefore, the Appellants respectfully submit that the errors set forth in the present reissue declaration are errors under 35 U.S.C. § 251 that are correctable by reissue, that the basis for the reissue is proper, and that the reissue oath/declaration is proper.

The Appellants request prompt action by the Board. The Federal Circuit and its predecessor, the Court of Customs and Patent Appeals (CCPA), have generally held that the reissue statute "is remedial in nature, based upon fundamental principles of equity and fairness, and should be construed liberally."¹ In the present application, the

¹ *In re Weiler*, 790 F.2d 1576, 1579, 229 USPQ 673, 675 (Fed. Cir. 1986); *see also In re Doyle*, 293 F.3d 1355, 1358, 63 USPQ2d 1161 (Fed. Cir. 2002); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 1479-80, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998); and *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 995, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993).

Appellants respectfully submit that the Patent Office has abused these fundamental principles of equity and fairness by continually delaying a prompt decision in all matters related to the present reissue application. Initially, for a period of 21 months, the Patent Office failed to consider the *Petition*. About four months later, only after issuance of the '991 patent, the Patent Office denied the *Petition*. Six months later, after filing a *Request for Reconsideration*, the Patent Office again denied the *Petition*. Two months after that, the present reissue application was filed, and the Patent Office waited another 26 months before issuing an Official Action. After the Applicants filed a *Response*, the Patent Office delayed issuance of a Final Official Action for a period of three years after filing of the present reissue application. The Applicants conducted an interview three months after the date of the Final Official Action, and agreement was reached, as noted on the record in the *Interview Summary* of mailed April 5, 2005, that "[r]eissue can be used to correct an error involving a Terminal Disclaimer." The agreement with the Examiner was based on the Durckheimer decision. Contrary to this agreement, the Patent Office delayed another two years before rescinding the previous Official Action and issuing a new non-final Official Action, which was more than five years after the filing of the present reissue application. After the Applicants filed a Notice of Appeal in July 2007, and an Appeal Brief in September 2007, the Patent Office again delayed almost two more years before issuing the *Examiner's Answer* on September 11, 2009, which was more than seven years after filing the present reissue application. The actions of the Patent Office are, as stated in the *Appeal Brief*, more and more clearly becoming arbitrary and capricious, particularly in light of the clear guidance of the MPEP and previous decisions. In the interests of fundamental principles of equity and fairness, the Appellants turn to the Board for resolution of this matter.

For the reasons set forth in the '235 and '902 applications and in the present appeal, the *Petition Under 37 CFR § 1.182 To Withdraw a Terminal Disclaimer* should be granted, the *Terminal Disclaimer* should be withdrawn, and the face of the patent should be corrected by reissuing the '991 patent in order to delete the following on the face of the patent: "This patent is subject to a terminal disclaimer." If other suitable

remedies are available to correct the errors in the present patent, the Appellants respectfully request that such actions be taken. If further discussions would expedite prosecution of this application, please contact the undersigned.

Respectfully submitted,



Eric J. Robinson
Reg. No. 38,285

Robinson Intellectual Property Law Office, P.C.
PMB 955
21010 Southbank Street
Potomac Falls, Virginia 20165
(571) 434-6789